

§ 6.2

43. Services for providing food and drink; temporary accommodation.

44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

45. Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

[72 FR 28611, May 22, 2007]

§ 6.2 Prior U.S. schedule of classes of goods and services.

Class	Title
GOODS	
1	Raw or partly prepared materials.
2	Receptacles.
3	Baggage, animal equipments, portfolios, and pocket books.
4	Abrasives and polishing materials.
5	Adhesives.
6	Chemicals and chemical compositions.
7	Cordage.
8	Smokers' articles, not including tobacco products.
9	Explosives, firearms, equipments, and projectiles.
10	Fertilizers.
11	Inks and inking materials.
12	Construction materials.
13	Hardware and plumbing and steamfitting supplies.
14	Metals and metal castings and forgings.
15	Oils and greases.
16	Protective and decorative coatings.
17	Tobacco products.
18	Medicines and pharmaceutical preparations.
19	Vehicles.
20	Linoleum and oiled cloth.
21	Electrical apparatus, machines, and supplies.
22	Games, toys, and sporting goods.
23	Cutlery, machinery, and tools, and parts thereof.
24	Laundry appliances and machines.
25	Locks and safes.
26	Measuring and scientific appliances.
27	Horological instruments.
28	Jewelry and precious-metal ware.
29	Brooms, brushes, and dusters.
30	Crockery, earthenware, and porcelain.
31	Filters and refrigerators.
32	Furniture and upholstery.
33	Glassware.
34	Heating, lighting, and ventilating apparatus.
35	Belting, hose, machinery packing, and nonmetallic tires.
36	Musical instruments and supplies.
37	Paper and stationery.
38	Prints and publications.
39	Clothing.
40	Fancy goods, furnishings, and notions.
41	Canes, parasols, and umbrellas.
42	Knitted, netted, and textile fabrics, and substitutes therefor.
43	Thread and yarn.
44	Dental, medical, and surgical appliances.
45	Soft drinks and carbonated waters.
46	Foods and ingredients of foods.
47	Wines.
48	Malt beverages and liquors.
49	Distilled alcoholic liquors.
50	Merchandise not otherwise classified.
51	Cosmetics and toilet preparations.
52	Detergents and soaps.

37 CFR Ch. I (7–1–10 Edition)

Class	Title
SERVICES	
100	Miscellaneous.
101	Advertising and business.
102	Insurance and financial.
103	Construction and repair.
104	Communication.
105	Transportation and storage.
106	Material treatment.
107	Education and entertainment.

[24 FR 10383, Dec. 22, 1959. Redesignated at 38 FR 14681, June 4, 1973]

§ 6.3 Schedule for certification marks.

In applications for registration of certification marks based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications, goods and services are classified in two classes as follows:

A. Goods.

B. Services.

[73 FR 67775, Nov. 15, 2008]

§ 6.4 Schedule for collective membership marks.

All collective membership marks in applications based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications are classified as follows:

Class	Title
200	Collective Membership.

[73 FR 67775, Nov. 17, 2008]

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Subpart A—General Information

Sec.

7.1 Definitions of terms as used in this part.

7.2 [Reserved]

7.3 Correspondence must be in English.

7.4 Receipt of correspondence.

7.5 [Reserved]

7.6 Schedule of U.S. process fees.

7.7 Payments of fees to International Bureau.

**Subpart B—International Application
Originating From the United States**

- 7.11 Requirements for international application originating from the United States.
- 7.12 Claim of color.
- 7.13 Certification of international application.
- 7.14 Correcting irregularities in international application.

**Subpart C—Subsequent Designation
Submitted Through the Office**

- 7.21 Subsequent designation.

**Subpart D—Recording Changes to
International Registration**

- 7.22 Recording changes to international registration.
- 7.23 Requests for recording assignments at the International Bureau.
- 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

**Subpart E—Extension of Protection to the
United States**

- 7.25 Sections of part 2 applicable to extension of protection.
- 7.26 Filing date of extension of protection for purposes of examination in the Office.
- 7.27 Priority claim of extension of protection for purposes of examination in the Office.
- 7.28 Replacement of U.S. registration by registered extension of protection.
- 7.29 Effect of replacement on U.S. registration.
- 7.30 Effect of cancellation or expiration of international registration.
- 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

**Subpart F—Affidavit Under Section 71 of
the Act for Extension of Protection to
the United States**

- 7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.
- 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.
- 7.38 Notice to holder of extension of protection.
- 7.39 Acknowledgment of receipt of and correcting deficiencies in affidavit or declaration of use in commerce or excusable nonuse.
- 7.40 Petition to Director to review refusal.

**Subpart G—Renewal of International
Registration and Extension of Protection**

- 7.41 Renewal of international registration and extension of protection.

AUTHORITY: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

SOURCE: 68 FR 55769, Sept. 26, 2003, unless otherwise noted.

Subpart A—General Information**§ 7.1 Definitions of terms as used in
this part.**

(a) *the Act* means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. 1051 *et seq.*

(b) *Subsequent designation* means a request for extension of protection of an international registration to a Contracting Party made after the International Bureau registers the mark.

(c) The acronym *TEAS* means the Trademark Electronic Application System available on-line through the Office's Web site at: www.uspto.gov.

(d) The term *Office* means the United States Patent and Trademark Office.

(e) All references to sections in this part refer to 37 Code of Federal Regulations, except as otherwise stated.

§ 7.2 [Reserved]**§ 7.3 Correspondence must be in
English.**

International applications and registrations, requests for extension of protection and all other related correspondence with the Office must be in English. The Office will not process correspondence that is in a language other than English.

§ 7.4 Receipt of correspondence.

(a) *Correspondence Filed Through TEAS.* Correspondence relating to international applications and registrations and requests for extension of protection submitted through TEAS will be accorded the date and time on which the complete transmission is received in the Office based on Eastern Time. Eastern Time means eastern standard time or eastern daylight time, as appropriate.

(b) *Correspondence Filed By Mail.* International applications under § 7.11, subsequent designations under § 7.21,

§ 7.5

37 CFR Ch. I (7–1–10 Edition)

responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacement under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be addressed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

(1) International applications under § 7.11, subsequent designations under § 7.21, requests to record changes in the International Register under § 7.23 and § 7.24, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, will be accorded the date of receipt in the Office, unless they are sent by Express Mail pursuant to § 2.198 of this title, in which case they will be accorded the date of deposit with the United States Postal Service.

(2) Responses to notices of irregularity under § 7.14, requests to note replacement under § 7.28, and requests for transformation under § 7.31, when filed by mail, will be accorded the date of receipt in the Office.

(c) *Hand-Delivered Correspondence.* International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under §§ 7.23 and 7.24, requests to note replacement under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, may be delivered by hand during the hours the Office is open to receive correspondence. Madrid-related hand-delivered correspondence must be delivered to the Trademark Assistance Center, James Madison Building—East Wing, Concourse Level, 600 Dulany Street, Alexandria, VA 22314, Attention: MPU.

(d) *Facsimile Transmission Not Permitted.* The following documents may not be sent by facsimile transmission, and will not be accorded a date of receipt if sent by facsimile transmission:

(1) International applications under § 7.11;

(2) Subsequent designations under § 7.21;

(3) Responses to notices of irregularity under § 7.14;

(4) Requests to record changes of ownership under § 7.23;

(5) Requests to record restrictions of the holder's right of disposal, or the release of such restrictions, under § 7.24; and

(6) Requests for transformation under § 7.31.

(e) *Certificate of Mailing or Transmission Procedure Does Not Apply.* The certificate of mailing or transmission procedure provided in § 2.197 does not apply to the documents specified in paragraph (d) of this section.

[69 FR 57185, Sept. 24, 2004, as amended at 69 FR 63321, Nov. 1, 2004; 72 FR 18908, Apr. 16, 2007]

§ 7.5 [Reserved]

§ 7.6 Schedule of U.S. process fees.

(a) The Office requires the following process fees:

(1) For certifying an international application based on a single basic application or registration, per class—\$100.00

(2) For certifying an international application based on more than one basic application or registration, per class—\$150.00

(3) For transmitting a subsequent designation under § 7.21—\$100.00

(4) For transmitting a request to record an assignment or restriction, or release of a restriction, under § 7.23 or § 7.24—\$100.00

(5) For filing a notice of replacement under § 7.28, per class—\$100.00

(6) For filing an affidavit under § 71 of the Act, per class—\$100.00

(7) Surcharge for filing an affidavit under § 71 of the Act during the grace period, per class—\$100.00

(8) For correcting a deficiency in a section 71 affidavit—\$100.00

(b) The fees required in paragraph (a) of this section must be paid in U.S. dollars at the time of submission of the requested action. See § 2.207 of this

chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

[68 FR 55769, Sept. 26, 2003, as amended at 75 FR 35977, June 24, 2010]

§ 7.7 Payments of fees to International Bureau.

(a) For documents filed through TEAS, the following fees may be paid either directly to the International Bureau or through the Office:

- (1) International application fees;
- (2) Subsequent designation fees; and
- (3) Recording fee for an assignment of an international registration under § 7.23.

(b) The fees in paragraph (a) of this section may be paid as follows:

(1)(i) Directly to the International Bureau by debit to a current account with the International Bureau. In this case, an applicant or holder's submission to the Office must include the International Bureau account number; or

(ii) Directly to the International Bureau using any other acceptable method of payment. In this case, an applicant or holder's submission to the Office must include the International Bureau receipt number for payment of the fees; or

(2) Through the Office. Fees paid through the Office must be paid in U.S. dollars at the time of submission. See § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

(c) All fees for paper filings must be paid directly to the International Bureau.

(d) The International Bureau fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at: <http://www.wipo.int/madrid/en/>.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57185, Sept. 24, 2004]

Subpart B—International Application Originating From the United States

§ 7.11 Requirements for international application originating from the United States.

(a) The Office will grant a date of receipt to an international application That is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The international application must include all of the following:

(1) The filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;

(2) The name and entity of the international applicant that is identical to the name and entity of the applicant or registrant in the basic application or basic registration, and the applicant's current address;

(3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and that meets the requirements of § 2.52 of this title.

(i) If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the reproduction of the mark in the international application must be black and white.

(ii) If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark.

(iii) If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color.

(iv) If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide, and must appear in the box designated by the International Bureau on the International Bureau's official form;

(4) A color claim as set out in § 7.12, if appropriate;

(5) A description of the mark that is the same as the description of the

§ 7.12

mark in the basic application or registration, as appropriate;

(6) An indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;

(7) A list of the goods and/or services that is identical to or narrower than the list of goods and/or services in each claimed basic application or registration and classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*;

(8) A list of the designated Contracting Parties. If the goods and/or services in the international application are not the same for each designated Contracting Party, the application must list the goods and/or services in the international application that pertain to each designated Contracting Party;

(9) The certification fee required by § 7.6;

(10) If the application is filed through TEAS, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (see § 7.7);

(11) A statement that the applicant is entitled to file an international application in the Office, specifying that applicant: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of its U.S. domicile or establishment; and

(12) If the international application is filed through TEAS, an e-mail address for receipt of correspondence from the Office.

(b) For requirements for certification, see § 7.13.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57185, Sept. 24, 2004; 73 FR 67775, Nov. 17, 2008]

§ 7.12 Claim of color.

(a) If color is claimed as a feature of the mark in the basic application and/or registration, the international appli-

37 CFR Ch. I (7–1–10 Edition)

cation must include a statement that color is claimed as a feature of the mark and set forth the same name(s) of the color(s) claimed in the basic application and/or registration.

(b) If color is not claimed as a feature of the mark in the basic application and/or registration, color may not be claimed as a feature of the mark in the international application.

§ 7.13 Certification of international application.

(a) When an international application contains all the elements set forth in § 7.11(a), the Office will certify to the International Bureau that the information contained in the international application corresponds to the information contained in the basic application(s) and/or basic registration(s) at the time of certification, and will then forward the international application to the International Bureau.

(b) When an international application does not meet the requirements of § 7.11(a), the Office will not certify or forward the international application. If the international applicant paid the international application fees (see § 7.7) through the Office, the Office will refund the international fees. The Office will not refund the certification fee.

§ 7.14 Correcting irregularities in international application.

(a) *Response period.* Upon receipt of a notice of irregularities in an international application from the International Bureau, the applicant must respond to the International Bureau within the period set forth in the notice.

(b) *Classification and Identification of Goods and Services.* Responses to International Bureau notices of irregularities in the classification or identification of goods or services in an international application must be submitted through the Office for forwarding to the International Bureau. The Office will review an applicant's response to a notice of irregularities in the identification of goods or services to ensure that the response does not identify goods or services that are broader than the scope of the goods or services in the basic application or registration.

(c) *Fees.* If the International Bureau notice of irregularities requires the payment of fees, the fees for correcting irregularities in the international application must be paid directly to the International Bureau.

(d) *Other Irregularities Requiring Response from Applicant.* Except for responses to irregularities mentioned in paragraph (b) of this section and payment of fees for correcting irregularities mentioned in paragraph (c) of this section, all other responses may be submitted through the Office in accordance with § 7.14(e), or filed directly at the International Bureau. The Office will forward timely responses to the International Bureau, but will not review the responses or respond to any irregularities on behalf of the international applicant.

(e) *Procedure for response.* To be considered timely, a response must be received by the International Bureau before the end of the response period set forth in the International Bureau's notice. Receipt in the Office does not fulfill this requirement. Any response submitted through the Office for forwarding to the International Bureau should be submitted as soon as possible, but at least one month before the end of the response period in the International Bureau's notice. The Office will not process any response received in the Office after the International Bureau's response deadline.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 73 FR 67776, Nov. 17, 2008]

Subpart C—Subsequent Designation Submitted Through the Office

§ 7.21 Subsequent designation.

(a) A subsequent designation may be filed directly with the International Bureau, or, if it meets the requirements of paragraph (b) of this section, submitted through the Office.

(b) The Office will grant a date of receipt to a subsequent designation that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The subsequent designation must contain all of the following:

(1) The international registration number;

(2) The serial number of the U.S. application or registration number of the U.S. registration that formed the basis of the international registration;

(3) The name and address of the holder of the international registration;

(4) A statement that the holder is entitled to file a subsequent designation in the Office, specifying that holder: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a holder's address is not in the United States, the holder must provide the address of its U.S. domicile or establishment;

(5) A list of goods and/or services that is identical to or narrower than the list of goods and/or services in the international registration;

(6) A list of the designated Contracting Parties. If the goods and/or services in the subsequent designation are not the same for each designated Contracting Party, the holder must list the goods and/or services covered by the subsequent designation that pertain to each designated Contracting Party;

(7) The U.S. transmittal fee required by § 7.6;

(8) If the subsequent designation is filed through TEAS, the subsequent designation fees (*see* § 7.7); and

(9) If the subsequent designation is filed through TEAS, an e-mail address for receipt of correspondence from the Office.

(c) If the subsequent designation is accorded a date of receipt, the Office will then forward the subsequent designation to the International Bureau.

(d) If the subsequent designation fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the subsequent designation to the International Bureau. The Office will notify the holder of the reason(s). If the holder paid the subsequent designation fees (*see* § 7.7) through the Office, the Office will refund the subsequent designation fees. The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a subsequent designation must be made directly with the International Bureau.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

Subpart D—Recording Changes to International Registration

§ 7.22 Recording changes to international registration.

Except as provided in §§ 7.23 and 7.24, requests to record changes to an international registration must be filed with the International Bureau. If a request to record an assignment or restriction of a holder's right of disposal of an international registration or the release of such a restriction meets the requirements of § 7.23 or 7.24, the Office will forward the request to the International Bureau. Section 10 of the Act and part 3 of this chapter are not applicable to assignments or restrictions of international registrations.

§ 7.23 Requests for recording assignments at the International Bureau.

A request to record an assignment of an international registration may be submitted through the Office for forwarding to the International Bureau only if the assignee cannot obtain the assignor's signature for the request to record the assignment.

(a) A request to record an assignment submitted through the Office must include all of the following:

- (1) The international registration number;
- (2) The name and address of the holder of the international registration;
- (3) The name and address of the assignee of the international registration;
- (4) A statement that the assignee: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its U.S. domicile or establishment;
- (5) A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;

(6) An indication that the assignment applies to the designation to the United States;

(7) A statement that the assignment applies to all the goods and/or services in the international registration, or if less, a list of the goods and/or services in the international registration that have been assigned that pertain to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6.

(b) If a request to record an assignment contains all the elements set forth in paragraph (a) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the assignment or the effect that the assignment has on the title of the international registration.

(c) If the request fails to contain all the elements set forth in paragraph (a) of this section, the Office will not forward the request to the International Bureau. The Office will notify the assignee(s) of the reason(s). If the assignee paid the fees to record the assignment (*see* § 7.7) through the Office, the Office will refund the recording fee. The Office will not refund the transmittal fee.

(d) Correspondence to correct any irregularities in a request to record an assignment must be made directly with the International Bureau.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

§ 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

(a) A party who obtained a security interest or other restriction of a holder's right to dispose of an international registration, or the release of such a restriction, may submit a request to record the restriction or release through the Office for forwarding to the International Bureau only if:

- (1) The restriction or release:
 - (i) Is the result of a court order; or
 - (ii) Is the result of an agreement between the holder of the international registration and the party restricting

the holder's right of disposal, and the signature of the holder cannot be obtained for the request to record the restriction or release;

(2) The party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and

(3) The restriction or release applies to the holder's right to dispose of the international registration in the United States.

(b) A request to record a restriction or the release of a restriction must be submitted by the party who obtained the restriction of the holder's right of disposal and include all the following:

(1) The international registration number;

(2) The name and address of the holder of the international registration;

(3) The name and address of the party who obtained the restriction;

(4) A statement that the party who submitted the request: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a party's address is not in the United States, the party must provide the address of its U.S. domicile or establishment;

(5) (i) A statement that the restriction is the result of a court order, or

(ii) Where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;

(6) A summary of the main facts concerning the restriction;

(7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6.

(c) If a request to record a restriction, or the release of a restriction, contains all the elements set forth in paragraph (b) of this section, the Office will forward the request to the Inter-

national Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the restriction, or its release, or the effect that the restriction has on the holder's right to dispose of the international registration.

(d) If the request fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the request. The Office will notify the party who submitted the request of the reason(s). The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a request to record a restriction of a holder's right to dispose of an international registration or the release of such a restriction must be made directly with the International Bureau.

Subpart E—Extension of Protection to the United States

§ 7.25 Sections of part 2 applicable to extension of protection.

(a) Except for §§ 2.22–2.23, 2.130–2.131, 2.160–2.166, 2.173, and 2.181–2.186, all sections in parts 2, 10, and 11 of this chapter shall apply to an extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless otherwise stated.

(b) The Office will refer to a request for an extension of protection to the United States as an application under section 66(a) of the Act, and references to applications and registrations in part 2 of this chapter include extensions of protection to the United States.

(c) Upon registration in the United States under section 69 of the Act, an extension of protection to the United States is referred to as a registration, a registered extension of protection, or a section 66(a) registration.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 70 FR 38774, July 6, 2005; 73 FR 47686, Aug. 14, 2008; 73 FR 67776, Nov. 17, 2008; 75 FR 35977, June 24, 2010]

§ 7.26 Filing date of extension of protection for purposes of examination in the Office.

(a) If a request for extension of protection of an international registration to the United States is made in an international application and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e) of this chapter, the filing date of the extension of protection to the United States is the international registration date.

(b) If a request for extension of protection of an international registration to the United States is made in a subsequent designation and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e), the filing date of the extension of protection to the United States is the date that the International Bureau records the subsequent designation.

§ 7.27 Priority claim of extension of protection for purposes of examination in the Office.

An extension of protection of an international registration to the United States is entitled to a claim of priority under section 67 of the Act if:

(a) The request for extension of protection contains a claim of priority;

(b) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; and

(c) The date of the international registration or the date of recording of the subsequent designation at the International Bureau of the request for extension of protection to the United States is not later than six months after the filing date of the application that forms the basis for the claim of priority.

§ 7.28 Replacement of U.S. registration by registered extension of protection.

(a) A registered extension of protection affords the same rights as those afforded to a previously issued U.S. registration if:

(1) Both registrations are owned by the same person and identify the same mark; and

(2) All the goods and/or services listed in the U.S. registration are also listed in the registered extension of protection.

(b) The holder of an international registration with a registered extension of protection to the United States that meets the requirements of paragraph (a) of this section may file a request to note replacement of the U.S. registration with the extension of protection. If the request contains all of the following, the Office will take note of the replacement in its automated records:

(1) The serial number or registration number of the extension of protection;

(2) The registration number of the replaced U.S. registration; and

(3) The fee required by § 7.6.

(c) If the request to note replacement is denied, the Office will notify the holder of the reason(s) for refusal.

§ 7.29 Effect of replacement on U.S. registration.

A U.S. registration that has been replaced by a registered extension of protection under section 74 of the Act and § 7.28 will remain in force, unless cancelled, expired or surrendered, as long as:

(a) The owner of the replaced U.S. registration continues to file affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act; and

(b) The replaced U.S. registration is renewed under section 9 of the Act.

§ 7.30 Effect of cancellation or expiration of international registration.

When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.

§ 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

If the International Bureau cancels an international registration in whole or in part, under Article 6(4) of the Madrid Protocol, the holder of that international registration may file a request to transform the corresponding pending or registered extension of protection to the United States into an application under section 1 or 44 of the Act.

(a) The holder of the international registration must file a request for transformation within three months of the date of cancellation of the international registration and include:

(1) The serial number or registration number of the extension of protection to the United States;

(2) The name and address of the holder of the international registration;

(3) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and

(4) An e-mail address for receipt of correspondence from the Office.

(b) If the request for transformation contains all the elements set forth in paragraph (a) of this section, the extension of protection shall be transformed into an application under section 1 and/or 44 of the Act and accorded the same filing date and the same priority that was accorded to the extension of protection.

(c) The application under section 1 and/or 44 of the Act that results from a transformed extension of protection will be examined under part 2 of this chapter.

(d) A request for transformation that fails to contain all the elements set forth in paragraph (a) of this section will not be accepted.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

Subpart F—Affidavit Under Section 71 of the Act for Extension of Protection to the United States

§ 7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.

(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.

(b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:

(1) On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and

(2) Within the year before the end of every ten-year period after the date of registration in the United States.

(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (b)(1) and (b)(2) of this section, with payment of the grace period surcharge per class required by section 71(a)(3) of the Act and § 7.6.

(c) For the requirements for the affidavit or declaration, see § 7.37.

[68 FR 55769, Sept. 26, 2003, as amended at 75 FR 35977, June 24, 2010]

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

A complete affidavit or declaration under section 71 of the Act must:

(a) Be filed by the holder of the international registration within the period set forth in § 7.36(b);

(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter by a person properly authorized to

§ 7.38

37 CFR Ch. I (7–1–10 Edition)

sign on behalf of the holder, attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

(1) A person with legal authority to bind the holder; or

(2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or

(3) An attorney as defined in § 11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the holder.

(c) Include the U.S. registration number;

(d)(1) Include the fee required by § 7.6 for each class of goods or services that the affidavit or declaration covers;

(2) If the affidavit or declaration is filed during the grace period under section 71(a)(3) of the Act, include the grace period surcharge per class required by § 7.6;

(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under § 7.37(f)(2);

(2) Specify the goods or services being deleted from the registration, if the affidavit or declaration covers less than all the goods or services or less than all the classes in the registration;

(f)(1) State that the registered mark is in use in commerce on or in connec-

tion with the goods or services in the registration; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and

(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 7.37(f)(2). The specimen must meet the requirements of § 2.56 of this chapter.

[68 FR 55769, Sept. 26, 2003, as amended at 73 FR 47686, Aug. 14, 2008; 75 FR 35977, June 24, 2010]

§ 7.38 Notice to holder of extension of protection.

The registration certificate for an extension of protection to the United States includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 71 of the Act. However, the affidavit or declaration must be filed within the time period required by section 71 of the Act regardless of whether this notice is received.

§ 7.39 Acknowledgment of receipt of and correcting deficiencies in affidavit or declaration of use in commerce or excusable nonuse.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) A response to the refusal must be filed within six months of the date of issuance of the Office action, or before the end of the filing period set forth in section 71(a) of the Act, whichever is later. The response must be signed by the holder, someone with legal authority to bind the holder (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(b) If no response is filed within this time period, the extension of protection will be cancelled, unless time remains in the grace period under section 71(a)(3) of the Act. If time remains in the grace period, the holder may file a complete, new affidavit.

(c) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 71(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(d) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.

[75 FR 35977, June 24, 2010]

§ 7.40 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. *See* § 7.39(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within six months of the date of issuance of the action maintaining the refusal, or the Office will cancel the registration.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

[68 FR 55769, Sept. 26, 2003, as amended at 73 FR 67776, Nov. 17, 2008]

Subpart G—Renewal of International Registration and Extension of Protection

§ 7.41 Renewal of international registration and extension of protection.

(a) Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.

(b) A request to renew an international registration or extension of protection to the United States submitted through the Office will not be processed.

INDEX II—RULES RELATING TO TRADEMARKS

EDITORIAL NOTE: This listing is provided for information purposes only. It is compiled and kept up-to-date by the Department of Commerce. This index is updated as of July 1, 2010.

Section

A

Abandonment of application or mark:	
During <i>inter partes</i> proceeding	2.135
Express abandonment.....	2.68
For failure to respond or to respond completely to official action	2.65(a)
For failure to timely file a statement of use	2.65(c)
Revival of abandoned application	2.66
Acceptance of affidavit under sec. 8.....	2.163
Access:	
To applications, and all proceedings relating thereto, after publication or registration.....	2.27(d)
To applications prior to publication	2.27(b)
To assignment records.....	2.200
To decisions of Director and the Trademark Trial and Appeal Board.....	2.27(c)
To materials filed under seal pursuant to a protective order	2.27(e); 2.126(d)
To pending trademark application index	2.27(a)
Acknowledgment of receipt of affidavit or declaration:	
Filed under sec. 8	2.163
Filed under sec. 71	7.39
Act, The, defined	2.2(a)
Action by assignee of record or owner	3.71, 3.73
Action by Examiner on application	2.61
Adding party to an interference.....	2.98
Address for correspondence with U.S. Patent and Trademark Office	2.190
Admissions, request for (discovery):	
Motion to determine sufficiency of response.....	2.120(h)
Timing of.....	2.120(a)
Use of admission.....	2.120(j)
When to file copy of request with Trademark Trial and Appeal Board	2.120(j)(8)
Advertising by attorneys and others, restricted.....	10.32
Affidavit or declaration:	
Claiming benefits of Act of 1946 under sec. 12(c).....	2.153
Combined secs. 8 and 15	2.168(a)
For incontestability under sec. 15	2.167
Of use in commerce or excusable nonuse under sec. 8	2.160-166
Of use in commerce or excusable nonuse under sec. 71	7.36-7.40
Reconsideration of, under sec. 8	2.163(b), 2.165
Reconsideration of, under sec. 71.....	7.39(b), 7.40
To avoid cancellation of registration under sec. 8.....	2.160-2.161
To avoid cancellation of registration under sec. 71	7.36-7.40
Agent. (See Attorneys and other representatives)	
Allegations in application or registration not evidence on behalf of ap- plicant or registrant in <i>inter partes</i> proceeding.....	2.122(b)(2)

37 CFR Ch. I (7–1–10 Edition)

Allowance, notice of	2.81(b), 2.88
Amendment of application:	
After final action	2.64(b)
After publication.....	2.35(b), 2.84(b)
Between notice of allowance and statement of use	2.77
Description or drawing of mark	2.72
Form of amendment	2.74
Involved in <i>inter partes</i> proceedings	2.133
To allege use	2.76
To change to different register	2.75
To correct informalities.....	2.71
To seek concurrent use registration	2.73
Amendment of pleadings in <i>inter partes</i> proceedings:	
Cancellation.....	2.115
Opposition.....	2.107
Amendment of registration:	
During <i>inter partes</i> proceedings	2.133
Requirements for, in general	2.173
Amendment to allege use	2.76
Amendments to description or drawing of mark after filing	2.72(b)(1)
Correction of deficiency in.....	2.76(g)
Fee for filing	2.6
Filed during final action response period.....	2.64(c)
Minimum requirements for filing	2.76(e)
Requirements for	2.76(b)
Time for filing.....	2.76(a)
Withdrawal of	2.76(h)
Answer to pleadings in opposition and cancellation proceedings	2.106, 2.114
Contents of answer.	2.106(b)(1), 2.114(b)(1)
Corresponds to answer in court proceeding	2.116(c)
Counterclaim.....	2.106(b)(2), 2.114(b)(2)
Failure to timely answer.....	2.106(a), 2.114(a)
Answer to notice instituting concurrent use proceeding	2.99(d)
Failure to answer	2.99(d)(3)
Who needs to answer and when	2.99(d)(2)
Appeal to Court and civil action.....	2.145
Appeal to Court from decision of Director.....	2.145
Appeal to Court from decision of Trademark Trial and Appeal Board	2.145
Appeal to U.S. Court of Appeals for the Federal Circuit	2.145(a)
Civil action	2.145(c)
Extensions of time to appeal	2.145(e)
Notice of appeal to Court.....	2.145(c)(4)
Notice of appeal to U.S. Court of Appeals for the Federal Circuit	2.145(b)
Notice of election by appellee to proceed by civil action after appeal to U.S. Court of Appeals for the Federal circuit.....	2.145(c)(3)
Time for appeal or civil action	2.145(d)
Appeal to Trademark Trial and Appeal Board:	
Appropriate response to final refusal or second refusal on the same grounds	2.64(a), 2.141
Briefs on appeal	2.142(b)
Compliance with requirements not on appeal	2.142(c)
Failure of appellant to file brief.....	2.142(b)(1)
In multiple class applications	2.141(b)
Introduction of new evidence after filing of appeal	2.142(d)
Oral hearing on appeal.....	2.142(e)
Reconsideration of decision on appeal	2.144
Remand to Examiner re new issue prior to decision	2.142(f)

Index II

Reopening of examination of application after decision on appeal	2.142(g)
Time and manner of filing appeal	2.142(a)
Applicant:	
Foreign	2.24, 2.34(a)(3) and (4)
May be represented by an attorney	2.11
Name of	2.21, 2.32(c)
Signature and oath or declaration	2.33
Application for registration	2.21-2.47
Access to pending applications	2.27
Amendment of. See Amendment of application.	
Basis for filing	2.34, 2.35
Certification mark	2.45
Collective mark	2.44
Color claim in	2.52(b)(1)
Concurrent use	2.42, 2.73, 2.99
Conflicting marks, co-pending applications for	2.83
Description of mark	2.37
Different classes may be combined	2.86
Dividing of applications	2.87
Drawing required	2.51
Extension of protection of international registration to United States	7.25-7.41
Filing-date requirements	2.21
Form of application	2.32-2.47
For international registration. See International registration, application for	
Must be in English	2.32(a)
Principal Register	2.46
Priority claim based on foreign application	2.34(a)(4), 7.27
Prior registrations should be identified	2.36
Requirements for drawings	2.52, 2.53, 2.54
Requirements for written application	2.32, 2.34
Service mark	2.43
Signature of	2.32(b), 2.33
Specimens filed with	2.56, 2.59
Supplemental Register	2.47
Verification of	2.32(b), 2.33
Assignee:	
Certificate of registration may be issued to	3.85
New certificate of registration may be issued to	2.171
Not domiciled in U.S.	3.61
Right to take action when assignment is recorded or proof of assignment has been submitted	3.71, 3.73
Assignment of registered marks or marks subject to pending applications	3.1-3.85, 7.23
Cover sheet required to record	3.31, 3.41
Effect of recording	3.54
Electronically-filed requests to record	3.25(c)(1), 3.31(a)(7)
Extension of protection of international registration to U.S., assignment of	7.22, 7.23
Original documents should not be submitted for recordation	3.25, 3.34(b)
Recording in U.S. Patent and Trademark Office of assignments or other instruments relating to such marks	3.11
Recording of changes to International registrations or applications not applicable	7.22
Records open to public inspection	2.200, 2.201(b)
Requirements for recording	3.25-3.31, 3.41
Assignment of trial dates in <i>inter partes</i> proceedings	2.120(a), 2.121
Consolidated proceedings	2.121(b)(2)

37 CFR Ch. I (7–1–10 Edition)

Counterclaim	2.121(b)(2)
Discovery period	2.120(a)
Extending, Rescheduling	2.120(a), 2.121(a)(1), (c), (d)
Testimony periods	2.121
Trial order mailed with notice of institution	2.120(a)
Attorney conflict of interest	2.61(c), 10.61-10.68
Attorneys and other representatives	2.11, 2.17-2.19, 2.119(d), 10.1-10.112, 11-1-11.62
Authentication of copies of registrations and records	2.200(a)(2)

B

Basis for filing an application	2.34, 2.35
Bona fide intention to use	2.34(a)(2)(i), 2.34(a)(3)(i), 2.34(a)(4)(i), 2.89(a)(3), (b)(3)
Briefs:	
At final hearing in <i>inter partes</i> case	2.128
Failure of appellant to file brief on appeal	2.142(b)(1)
Failure of <i>inter partes</i> plaintiff to file brief at final hearing	2.128(a)(3)
Failure to file brief on <i>inter partes</i> motion	2.127(a)
On appeal to Trademark Trial and Appeal Board	2.142(b)
On motions in <i>inter partes</i> cases	2.127(a), (e)(1)
On petitions to Director	2.146(c), (e)
Burden of proof in an interference	2.96
Business with U.S. Patent and Trademark Office to be conducted with decorum and courtesy	2.192
Business with U.S. Patent and Trademark Office transacted in writ- ing	2.191

C

Cancellation of registrations (See also International Registration, cancellation of):	
By cancellation proceeding—pleadings and procedure	2.111
(See also Petition for Cancellation)	
By registrant	2.134, 2.172
For failure to file affidavit or declaration of use under sec. 8	2.160-2.166
For failure to file affidavit or declaration of use under sec. 71	7.36-7.40
During cancellation proceeding	2.134(b)
Cases not specifically defined in rules, petition to the Director	2.146(a)(4)
Certificate of correction of registration	2.174, 2.175
Certificate of mailing by first class mail	2.197
Certificate of registration:	
As evidence in <i>inter partes</i> proceeding	2.122(b), (d), (e)
Contents	2.151
In Registered extension of protection of international registration to United States	7.28
Issuance of new certificate to assignee	2.171
When and how issued	2.81, 2.82, 2.151
Certificate of transmission	2.197
Certification mark	2.45, 2.56(a)(5)
Certification of international application	7.13
Certified copies of registrations and records	2.201
Citizenship of applicant	2.32(a)(3)
Civil action:	
From decision of Director	2.145(c)
From decision of Trademark Trial and Appeal Board	2.145(c)
Notice of election by appellee to proceed by civil action after appeal to U.S. Court of Appeals for the Federal Circuit	2.145(c)(3)
Notice to Trademark Trial and Appeal Board of election to commence civil action for review of Board decision	2.145(c)(4)

Index II

Suspension of action in application pending outcome	2.67
Suspension of <i>inter partes</i> proceedings pending outcome	2.117
Time for commencing civil action from decision of Director or Trade- mark Trial and Appeal Board	2.145(d)
Waiver of right to proceed by civil action in <i>ex parte</i> case	2.145(c)(2)
Civil Procedure, Federal Rules of, applied to <i>inter partes</i> proceedings	2.116(a), 2.120(a)
Claim of benefits of Act of 1946 for marks registered under prior Acts	2.153-2.156
Classification of goods and services	2.85
Application limited to single class	2.86(a)
Combined applications	2.86(b)
Schedules of classes	6.1-6.4
Code of Professional Responsibility	10.20-10.112
Collective mark	2.44, 2.56(a)(3)
Color claim:	
In application for registration in United States	2.52(b)(1)
In application for international registration	7.11(a)(4), 7.12
Combined applications	2.86
Combined <i>inter partes</i> proceedings:	
Cancellation	2.112(b)
Opposition	2.104(b)
Commencement of cancellation	2.111(a)
Commencement of opposition	2.101(a)
Communication with attorney or other representative	2.18
Complaints against U.S. Patent and Trademark Office employees	2.192
Compliance of applicant with other laws	2.69
Compliance with discovery order of Trademark Trial and Appeal Board	2.120(g)
Compulsory counterclaim	2.106(b)(2)(i), 2.114(b)(2)(i)
Concurrent use registration	2.42, 2.99
Amendment to seek	2.73, 2.75(c)
Answer to notice of concurrent use proceeding, by whom and when	2.99(d)
Application requirements	2.42
Based upon court determination	2.99(f)
Burden of proving entitlement to	2.99(e)
Consideration and determination by Trademark Trial and Appeal Board	2.99(h), 2.133(c)
Examination by Examiner	2.99(a), (b)
Intent-to-use applications, when subject to	2.73(b), 2.99(g)
Mark must first be published for opposition purposes	2.99(b)
Notice of concurrent use proceeding	2.99(c), (d)
Registrations and applications to register on Supplemental Register and registrations under Act of 1920 not subject to	2.99(g)
Request to divide application during concurrent use proceeding	2.87(c)(1)
Conduct of practitioners	10.20-10.112, 11-1-11.62
Conference, pre-trial, in <i>inter partes</i> cases	2.120(i)(2)
Conference, telephone, in <i>inter partes</i> cases	2.120(i)(1)
Confidential matters	2.27(e), 2.125(e), 2.126(d)
Conflict of interest, attorney	2.61(c), 10.61-10.68
Conflicting marks, co-pending applications for	2.83, 2.91
Consent of applicant or authorized representative to withdrawal of oppo- sition after answer	2.106(c)
Consent of opposer to abandonment of application or mark	2.135
Consent of petitioner to surrender or voluntary cancellation of registra- tion	2.134

37 CFR Ch. I (7–1–10 Edition)

Consent of registrant or authorized representative to withdrawal of cancellation after answer	2.114(c)
Consolidated <i>inter partes</i> proceedings:	
Filing consolidated petition to cancel	2.112(b)
Filing consolidated opposition	2.104(b)
Times for filing briefs	2.128(a)(2)
Times for taking testimony	2.121(b)(2)
Constructive use, entry of judgment subject to establishment of in <i>inter partes</i> proceedings	2.129(d)
Contested or <i>inter partes</i> cases	2.116 et seq.
Copies of registrations and records	2.6, 2.201
Correction of informalities by amendment	2.71
Correction of mistake in certificate of registration:	
Mistake by U.S. Patent and Trademark Office	2.174
Mistake by registrant	2.175
Mistake in international registration	7.22
Correspondence, addresses for	2.190, 7.4
Correspondence, with whom held	2.18, 2.24, 2.119(d)
Counterclaim in opposition and cancellation	2.106(b)(2), 2.114(b)(2)
Court determination as basis for concurrent use registration	2.99(f)
Courtesy and decorum in dealing with U.S. Patent and Trademark Office	2.192
Court of Appeals for the Federal Circuit, U.S., appeal to	2.145

D

Date of first use and first use in commerce:	
Amendment of	2.71(c)
Required in amendment to allege use	2.76(b)(1), (c)
Required in statement of use	2.88(b)(1), (c)
Required in use applications under sec. 1(a)	2.34(a)(1)(i) and (ii)
Date of use allegation in application or registration not evidence on behalf of applicant or registrant in <i>inter partes</i> case	2.122(b)(2)
Declaration in lieu of oath or verification	2.20
Declaration of interference	2.91
Default judgment for failure to offer evidence in <i>inter partes</i> proceeding	2.132(a)
Delay in responding to official action	2.66
Deposit accounts for paying fees	2.208
Depositions, discovery, in <i>inter partes</i> cases:	
Domestic party	2.120(b)
Foreign party or representative	2.120(c)
Motion to compel attendance	2.120(e)
Nonparty	2.120(b)
Time for taking	2.120(a)
Use of	2.120(j)
When to file with Trademark Trial and Appeal Board	2.120(j)(8)
Depositions, discovery or trial testimony, upon written questions	2.124
Depositions, trial testimony	2.123
Before whom taken	2.123(d)
Certification and filing	2.123(f)
Corresponds to the trial in court proceedings	2.116(e)
Effect of errors and irregularities	2.123(j)
Examination of witnesses	2.123(e)
Filing and service of testimony transcript	2.125
Form of depositions	2.123(g)
Inspection of depositions	2.27(d), 2.123(i)
Manner of taking	2.123(a)

Index II

Must be filed.....	2.123(h)
Notice of taking.....	2.123(c)
Protective order relating to transcript or exhibits	2.125(e)
Raising of objections	2.123(e), (j), (k)
Stipulations concerning	2.123(b)
Taken in foreign country.....	2.123(a)(2)
Timing	2.121
Description of mark in application	2.37, 2.52(b)(5)
Amendment to.....	2.72
Designation of representative by foreign applicant, registrant, or party:	
Application.....	2.24
Assignment	3.61
In <i>inter partes</i> proceeding	2.119(d)
Diligence, requirement for	2.66(a)(2), 2.146(i)
Director of United States Patent and Trademark Office:	
May suspend certain rules	2.146(a)(5), 2.148
Petition to	2.146
Disciplinary Proceedings.....	11.19 -11.62
Disclaimer:	
During <i>inter partes</i> cases	2.133
In part, of registered mark	2.173
Disclosures:	
Expert disclosures	2.120(a)(2)
Failure to make	2.120(e)
Filing with Board	2.120(j)(5), (8)
Initial disclosures	2.120(a)(2), (3)
Motion to compel.....	2.120(e)
Protective order	2.120(f)
Sanctions.....	2.120(g)(2)
Discovery depositions. See Depositions, discovery, in <i>inter partes</i> cases.	
Discovery procedure	2.120
Automatic disclosure and discovery provisions of Federal Rules of	
Civil Procedure applicable.....	2.120(a)
Discovery conference.....	2.120(a)
Discovery deposition of domestic party	2.120(b)
Discovery deposition of foreign party.....	2.120(c)
Discovery provisions of Federal Rules of Civil Procedure apply except	
as otherwise provided	2.120(a)
Failure to comply with discovery order of Trademark Trial and Appeal	
Board	2.120(g)
Interrogatories	2.120(d)(1)
Motion for order to compel discovery.....	2.120(d)(1), 2.120(e)
Motion for a protective order.....	2.120(f)
Place of production of documents and things.....	2.120(d)(2)
Pre-trial conference	2.120(i)(2)
Proceeding suspended pending decision on motion to compel	2.120(e)(2)
Request for admissions.....	2.120(h)
Sanctions for failure to comply with discovery order of Trademark	
Trial and Appeal Board	2.120(g)
Telephone conference	2.120(i)(1)
Time for discovery.....	2.120(a)
Use of discovery deposition, answer to interrogatory, or admission	2.120(j)
When to file discovery materials with Trademark Trial and Appeal	
Board.....	2.120(j)(8)
Dismissal:	
For failure to file brief on appeal to Trademark Trial and Appeal	
Board	2.142(b)(1)

37 CFR Ch. I (7–1–10 Edition)

For failure to take testimony or offer other evidence in <i>inter partes</i> case	2.132
Distinctiveness under sec. 2(f), proof of.....	2.41
Dividing an application.....	2.87
Dividing a registration	2.171(b)
Domestic representative of foreign applicant, registrant, or party:	
Application	2.24, 2.37
Assignment	3.61
In <i>inter partes</i> proceeding	2.119(d)
Domicile of applicant.....	2.32(a)(3)
Drawing	2.51-2.54
Amendment to mark in	2.72
Color in	2.52(b)(1)
Drawings required	2.51
Electronically-filed.....	2.52(c), 2.53
Paper	Paper
Requirements for drawing	2.52-2.54
Standard character drawing	2.52(a)
Typed drawing. See Standard character drawing	
Duplicate registrations, Office does not issue.....	2.48
Duration of registration:	
Cancellation for failure to file affidavit or declaration of use under sec. 8	2.160
Cancellation for failure to file affidavit or declaration of use under sec. 71	7.36
Renewal.....	2.181-2.186, 7.41
Term of original registrations and renewals	2.181

E

Electronic filing with Trademark Trial and Appeal Board	2.126(d)
Emergencies or interruptions in United States Postal Service.....	2.195(e)
“Entity”, defined.....	2.2(b)
Entry of judgment, in <i>inter partes</i> proceeding, subject to establishment of constructive use	2.129(d)
Evidence in <i>ex parte</i> appeal after notice of appeal.....	2.142(d)
Evidence in <i>inter partes</i> proceeding.....	2.122-2.125
Affidavits, stipulated testimony, and stipulated facts.....	2.123(b)
Allegations of use and specimens in applications and registrations	2.122(b)(2)
Discovery responses	2.120(j)
Exhibits attached to pleadings	2.122(c)
Files of applications or registrations which are subject matter of proceeding.....	2.122(b)(1)
Official records	2.122(e)
Printed publications	2.122(e)
Registration owned by any party to proceeding.....	2.122(d)(2)
Registration pleaded by opposer or petitioner	2.122(d)(1)
Rules of evidence	2.122(a)
Testimony from other proceedings between parties	2.122(f)
Testimony upon oral examination.....	2.123
Testimony upon written questions	2.124
Evidence of distinctiveness	2.41
Examination of applications	2.61
Examination of witnesses in <i>inter partes</i> proceeding.....	2.123(e)
Examiner’s appearance at <i>ex parte</i> appeal oral hearing	2.142(e)(2)
Examiner’s brief on appeal	2.142(b)
Examiner’s jurisdiction over an application	2.84
Exhibits attached to pleadings as evidence	2.122(c)

Index II

Forwarded to defendant by Trademark Trial and Appeal Board	2.105, 2.113
Exhibits, testimony, filing and service of.....	2.125
<i>Ex parte</i> appeal. (See Appeal to Trademark Trial and Appeal Board)	
<i>Ex parte</i> matter disclosed but not tried in <i>inter partes</i> case	2.131
Express abandonment of application or mark:	
During examination procedure.....	2.68
During <i>inter partes</i> proceeding	2.135
“Express Mail” procedure for filing of papers and fees.....	2.198
Express surrender or cancellation of registration:	
During <i>inter partes</i> proceeding	2.134
Requirements for	2.172
Extension of protection of international registration to United States	7.25-7.41
Affidavit of continued use or excusable nonuse required after registration	7.36-7.40
Assignment of	7.23
Basis for registration	2.34(a)(5), 2.35(a)
Certificate of registration	2.151, 7.28
Definitions of terms.....	7.1
Effect of cancellation or expiration of international registration	7.30
Filing date.....	7.26
Not registrable on Supplemental Register	2.47(c), 2.75(c)
Part 2 rules applicable	7.25(a)
Part 3 rules do not apply	7.22
Priority claim	7.27
Renewal.....	7.41
Registered extension of protection cannot be amended under Section 7 of the Act	7.25(a)
Replacement of U.S. registration by	7.28, 7.29
Trademark Rules of Practice applicable to.....	7.25
Transformation to U.S. application	2.195(d)(5), 7.31
Extension of time for discovery and testimony	2.120(a), 2.121(a), (c), (d)
Extension of time for filing opposition.....	2.102
Extension of time for filing statement of use	2.89
Fee for filing request for.....	2.6
Good cause showing, when necessary	2.89(b)(4), (d)
Request filed with statement of use.....	2.89(e)

F

Facsimile transmission, certificate of.....	2.197, 7.4(e)
Facsimile transmission of certain correspondence to U.S. Patent and Trademark Office	2.195(a)(3), (c), (d), 7.4(d)
Facsimiles as specimens.....	2.56(c)
Failure by appellant to file brief on <i>ex parte</i> appeal	2.142(b)(1)
Failure by Plaintiff to file brief at final hearing in <i>inter partes</i> proceeding	2.128(a)(3)
Failure to answer opposition.....	2.106(a)
Failure to answer petition for cancellation	2.114(a)
Failure to comply with discovery order	2.120(g)
Failure to comply with order relating to confidential testimony or exhibits	2.125(e)
Failure to file affidavit of use under sec. 8 or renewal application for registration in <i>inter partes</i> proceeding	2.134(b)
Failure to file brief on motion.....	2.127(a)
Failure to offer evidence other than U.S. Patent and Trademark Office records	2.132(b)
Failure to respond to official action	2.65

37 CFR Ch. I (7–1–10 Edition)

Failure to take testimony or offer other evidence	2.132(a)
Failure to timely file a statement of use.....	2.88(h)
Fax transmission, certificate of	2.197
Fax transmission of certain correspondence to U.S. Patent and Trade- mark Office.....	2.195(a)(3), (c), (d)
Federal Rules of Civil Procedure.....	2.116(a), 2.122(a)
Federal Rules of Evidence	2.122(a)
Fees and charges.....	2.6, 2.206-2.209, 7.6, 7.7
For filing an application.....	2.6(a)(1)
For TEAS Plus application.....	2.6(a)(1)(iii), 2.21, 2.22
Payable to International Bureau.....	7.7
Fees, insufficient amount submitted:	
For application	2.21(a)(5)
For petition for cancellation	2.111(c)
For <i>ex parte</i> appeal.....	2.141(b)
For opposition	2.101(d)
For renewal application	2.183(b) and (f)
Fees, payment of.....	2.6, 2.206-2.207, 7.6, 7.79
To International Bureau.....	7.7
Filing an amendment to allege use	2.76
Filing an extension of protection under 66(a)	2.34(a)(5)
Filing an opposition.....	2.101
Filing and service of trial testimony	2.125
Filing by CD Rom	2.126(b)
Filing date, effective, after amendment of sec. 1(b) application to Supple- mental Register	2.75(b)
Filing date of application	2.21, 7.26
Filing of confidential papers	2.125(e), 2.126(d)
Filing of papers electronically	2.126(c)
Filing of papers and fees by Express Mail.....	2.198
Filing petition for cancellation	2.111
Filing requests for extensions of time for filing statement of use.....	2.89
Filing statement of use after notice of allowance.....	2.88
Filing substitute specimens	2.59
Final refusal of application.....	2.64(a)
Filing amendment to allege use during final action response pe- riod.....	2.64(c)
Reconsideration of	2.64(a)
Final hearing, briefs at (<i>inter partes</i> proceeding)	2.128
Foreign applicant, registrant, or party, designation of domestic rep- resentative	2.24, 2.37, 2.119(d), 3.61
Foreign application, priority claim based on	2.34(a)(4), 7.27
Foreign registration:	
Application based on, under sec. 44	2.34(a)(3), 2.47(b)
Copy of	2.34(a)(2)
Necessary before publication.....	2.34(a)(3)(ii)
Form of amendment to application.....	2.74
Form of submissions to TTAB	2.126

G

General information and correspondence	2.190-2.198, 7.4
Goods and/or services identification of:	
Additions not permitted	2.71(a)
Amendment of.....	2.71(a)
Amendment of, filed with statement of use.....	2.88(i)
In affidavit or declaration filed under sec. 8.....	2.161(e)
In affidavit or declaration filed under sec. 71.....	7.37(e)

Index II

In international application.....	7.11(a)(7)
In written application	2.32(a)(6)
Multiple goods or services comprised in single class or multiple classes.....	2.32(a)(6), 2.34(a)(1)(v), 2.86
Required in amendment to allege use	2.76(b)(1), (c)
Required in request for extension of time to file statement of use	2.89(a)(3), (f)
Required in statement of use.....	2.88(b)(1), (c), (i)
Good cause, showing necessary for extension of time to file statement of use	2.89(b)(4), (d)

H

Hearing, oral:	
At final hearing in <i>inter partes</i> proceeding	2.129
On appeal to Trademark Trial and Appeal Board	2.142(e)
On motion in <i>inter partes</i> proceedings	2.127(a)
On petition to Director	2.146(f)

I

Identification of goods and/or services. (See Goods and/or services identification of)	
Identification of pending application or registered mark in correspondence.....	2.194
Identification of prior registrations.....	2.36
Incontestability of right to use mark:	
Affidavit under sec. 15.....	2.167
Freedom from interference proceeding	2.91(b)
Informalities, amendment to correct	2.71
Intent-to-use applications under sec. 1(b):	
Abandonment for failure to timely file a statement of use	2.65(c)
Amendment to allege use	2.76
Amendments between notice of allowance and statement of use	2.77
Basis for filing application	2.34, 2.37
Bona fide intention to use mark in commerce necessary	2.34(a)(2)(i)
Certification mark	2.45
Collective mark.....	2.44
Dividing.....	2.87
Drawing required	2.32(c), 2.51
Extensions of time for filing statement of use.....	2.89
Filing-date requirements	2.21
Notice of allowance	2.81(b)
Requirements for written application	2.32, 2.34(a)(2)
Revival of application abandoned for failure to timely file a statement of use	2.66
Specimens filed with amendment to allege use or statement of use	2.56, 2.76, 2.88
Statement of use	2.88
When eligible for concurrent use.....	2.73(b), 2.99(g)
When eligible for amendment to Supplemental Register	2.47(c), 2.75(c)
Interlocutory motions, <i>inter partes</i> proceeding	2.127
Interference	2.91-2.93, 2.96, 2.98
Adding Party to interference	2.98
Burden of proof.....	2.96
Conflicting marks, co-pending applications for	2.83
Declaration of interference	2.91
Declared only on petition to Director.....	2.91(a)
Institution of interference	2.93
Issue	2.96

37 CFR Ch. I (7–1–10 Edition)

Marks must otherwise be deemed registrable	2.92
Notice of interference	2.93
Preliminary to interference	2.92
Registrations and applications on the Supplemental Register, registrations under the Act of 1920, and registrations of incontestable marks not subject to interference.....	2.91(b)
Request to divide application during interference	2.87(c)(1)
International application	7.11-7.14
Address for mailing paper	2.190(a), 7.4(b)
Cannot be filed by fax.....	2.195(d)(5), 7.4(d)
Certificate of mailing or transmission does not apply	2.197(a)(2)
Certification of.....	7.13
Claim of color in.....	7.12
Correspondence, receipt of.....	7.4
Definitions of terms.....	7.1
Fees for	7.6, 7.7
Hand delivery of.....	7.4(c)
Irregularities in	2.195(d)(5), 7.4(b)(2), 7.14
Must be filed through TEAS or on International Bureau's form	7.11(a)
Must be in English	7.3
Requirements for.....	7.11
Subsequent designation.....	7.21
International Bureau	7.1, 7.11, 7.13, 7.14, 7.21, 7.22, 7.23, 7.24, 7.26, 7.27, 7.30, 7.31, 7.36, 7.41
Payment of fees to	7.7
International register, recording changes in. See also International registration	7.22-7.24
International registration	7.1-7.41
Application for. See International application.	
Assignment of	7.23
Cancellation of.....	7.30, 7.31
Correspondence must be in English	7.3
Definitions of terms.....	7.1
Extension of protection to United States. See Extension of protection of international registration to United States	
Priority claim	7.27
Recording changes in.....	2.195(d)(5), 7.22-7.24
Renewal of.....	7.41
Replacement	7.28, 7.29
Restriction on holder's right to dispose of.....	7.24
Subsequent designation.....	7.21
<i>Inter partes</i> procedure.....	2.116-2.136
<i>Inter partes</i> proceedings	2.91-2.136
Cancellation	2.111-2.115
Concurrent use	2.99
Failure of plaintiff to file brief at final hearing	2.128(a)(3)
Failure of plaintiff to take testimony	2.132
Interference	2.91-2.93, 2.96, 2.98
Opposition	2.101-2.107
Procedure in	2.116-2.136
Interrogatories (discovery)	2.120
Motion for an order to compel answer.....	2.120(d)(1), 2.120(e)
Numerical limit on	2.120(d)(1)
Timing of.....	2.120(a)
Use of answers	2.120(j)
When to file copy of interrogatories and answers thereto with Trademark Trial and Appeal Board.....	2.120(j)(8)
Interruptions or emergencies in United States Postal Service	2.195(e)

Index II

Irregularities in application for international registration. (See International application, irregularities in)	
Issue date of the notice of allowance	2.81(b)

J

Judgment by default:	
Failure by plaintiff to file brief at final hearing	2.128(a)(3)
Failure to answer cancellation	2.114(a)
Failure to answer notice of concurrent use proceeding	2.99(d)(3)
Failure to answer opposition	2.106(a)
Failure to take testimony or offer other evidence	2.132
Judgment, entry of in <i>inter partes</i> proceeding subject to establishment of	
constructive use	2.129(d)
Jurisdiction over published applications	2.84
Amendment after publication of mark	2.84(b)
Amendment during <i>inter partes</i> proceeding	2.133
Remand to Examiner by Trademark Trial and Appeal Board	2.130, 2.131

L

Lawyers. (See Attorneys)	
Letter, separate for each distinct subject of inquiry	2.193(a), (b)
Letters, address for mailing to U.S. Patent and Trademark Office	2.190

M

Madrid Protocol. (See International registration, international application)	
Mailing, certificate of	2.197
Mailing address for correspondence with U.S. Patent and Trademark Office	2.190, 7.4(b)
Marks on Supplemental Register published only upon registration	2.82
Marks registered under 1905 Act, claiming benefits of 1946 Act	2.153-2.156
Marks under sec. 12(c) not subject to opposition; subject to cancellation	2.156
Matters in evidence in <i>inter partes</i> cases	2.122
Mistake in registration incurred through fault of applicant	2.175
Mistake in registration incurred through fault of U.S. Patent and Trademark Office	2.174
Money, payment of	2.206-2.209, 7.6, 7.7
Motions in <i>inter partes</i> proceedings:	
Briefs on	2.127(a), 2.127(e)(1)
Contents	2.127(a)
Failure to respond to motion	2.127(a)
For a protective order	2.120(f)
For judgment for failure to take testimony	2.132
For summary judgment	2.127(e)
Interlocutory motions and requests, who may act on	2.127(c)
Request for reconsideration of decision on motion	2.127(b)
Suspension pending determination of motion potentially dispositive of proceeding	2.127(d)
To add application to interference	2.98
To compel discovery	2.120(d)(1), 2.120(e)
To determine sufficiency of answer or objection to request for admission	2.120(h)
To extend discovery period	2.120(a)
To extend times for taking testimony upon written questions	2.124(d)(2)
To extend trial periods	2.121(a), (c)
To suspend	2.117

37 CFR Ch. I (7–1–10 Edition)

To take oral deposition abroad.....	2.120(c)(1), 2.123(a)(2)
To use testimony from another proceeding between parties	2.122(f)
Multiple class applications	2.32(a)(6), 2.34(a)(1)(v)
Dividing of.....	2.87
Multiple goods or services comprised in single class or multiple class- es	2.86
Dividing of.....	2.87

N

New certificate on change of ownership	2.171
Notice by publication, undelivered Office notices	2.118
Notice of allowance	2.81(b)
Filing statement of use after	2.88
Issue date of	2.81(b)
Notice of appeal to court and civil action	2.145
Notice of appeal to Trademark Trial and Appeal Board.....	2.142(a)
Notice of concurrent use proceeding.....	2.99(c), (d)
Notice of claim of benefits of 1946 Act.....	2.153-2.156
Notice of election by appellee to proceed by civil action after appeal to U.S. Court of Appeals for the Federal Circuit.....	2.145(c)(3)
Notice of interference	2.93
Notice of publication under sec. 12(c)	2.155
Notice of reliance on discovery	2.120(j)
Notice of reliance on printed publications and official records.....	2.122(e)
Notice to Trademark Trial and Appeal Board of civil action	2.145(c)(4)
Notice, where address of registrant in cancellation proceeding is un- known.....	2.118
Notification of acceptance of or deficiency in amendment to allege use	2.76(f), (g)
Notification of acceptance of or deficiency in statement of use	2.88(f), (g)
Notification of filing of petition for cancellation.....	2.113
Notification of grant or denial of request for an extension of time to file a statement of use.....	2.89(g)
Notification of opposition.....	2.105

O

Oath, declaration in lieu of	2.20
Oaths, before whom and when made in testimonial deposition	2.123(e)(5)
<i>Official Gazette</i> contents:	
Claim of benefits under sec. 12(c) for marks registered under 1905 Act.....	2.154
First filed of applications for conflicting marks.....	2.83
Marks on Principal Register published for opposition	2.80
Marks on Supplemental Register published when registered.....	2.82
Official records, reliance on in <i>inter partes</i> proceeding	2.122(e)
Omission of matter from response to Examiner's action	2.65(b)
Opposition to registration of mark on Principal Register:	2.101-2.107
Amendment of opposition.....	2.107
Answer	2.106
Commencement of opposition	2.101(a)
Consolidated oppositions	2.104(b)
Contents of opposition	2.104
Corresponds to complaint in a court proceeding	2.116(c)
Discovery	2.120
Documents not returnable	2.25
Extension of time for filing an opposition.....	2.102
Failure to timely answer.....	2.106(a)

Index II

Filing an opposition.....	2.101
Insufficient fees	2.101(d)
Notification of opposition.....	2.105
Procedure, <i>inter partes</i>	2.116-2.136
Request to divide application during opposition.....	2.87(c)(1)
Suspension of proceedings	2.117
Time for filing opposition.....	2.101(c)
Who may file opposition.....	2.101(b)
Withdrawal of opposition.....	2.106(c)
Oral argument at final hearing in <i>inter partes</i> proceeding	2.129
Oral hearing:	
<i>Ex parte</i> appeal	2.142(e)
<i>Inter partes</i> proceedings	2.116(f), 2.127(a), 2.129
On petition to Director	2.146(f)
Oral promise, stipulation, or understanding.....	2.191
Ownership, prior registrations, identification in application	2.36

P

Payment of money.....	2.6, 2.206-2.209, 7.6, 7.7
Pending application index.....	2.27
Period for response to Office actions.....	2.62
Personal appearance unnecessary.....	2.191
Persons who may practice before the U.S. Patent and Trademark Office	
in trademark cases	11.14
Petition for cancellation	2.111-2.115
Amendment of petition	2.115
Answer	2.114
Commencement of cancellation proceeding	2.111(a)
Contents of petition.....	2.112
Corresponds to complaint in a court proceeding	2.116(c)
Discovery	2.120
Failure to timely answer.....	2.114(a)
Filing petition for cancellation	2.111
Insufficient fees	2.111(c)
Notification of cancellation proceeding	2.113
Procedure, <i>inter partes</i>	2.116-2.136
Suspension of proceedings	2.117
Time for filing petition	2.111(b)
Who may file petition.....	2.111(b)
Withdrawal of petition	2.114(c)
Petition for rehearing, reconsideration or modification of decision:	
Decision in <i>inter partes</i> proceeding.....	2.129(c)
Decision on <i>ex parte</i> appeal	2.144
Decision on interlocutory motion in <i>inter partes</i> proceeding	2.127(b)
Petition to revive abandoned application	2.66
Petition to the Director.....	2.146
Any case not specifically defined and provided for by rules.....	2.146(a)(4)
Contents of petition.....	2.146(c)
Delegation of authority to act on petitions	2.146(h)
Diligence, requirement for	2.146(i)
Extraordinary situation requiring suspension or waiver of requirement	
of rules.....	2.146(a)(5)
Fee.....	2.6, 2.146(c)
From denial of request for extension of time to file statement of	
use.....	2.89(g)
From grant or denial of request for extension of time to oppose	2.146(e)(1)
From interlocutory order of Trademark Trial and Appeal Board	2.146(e)(2)

37 CFR Ch. I (7–1–10 Edition)

Invoke supervisory authority	2.146(a)(3)
Oral hearing on petition.....	2.146(f)
Reconsideration of decision on petition.....	2.146(j)
Reconsideration of refusal to accept sec. 8 affidavit or declaration.....	2.165(b)
Refusal of renewal of registration	2.186
Relief from repeated formal requirement of Examiner.....	2.63(b), 2.146(a)(1)
Review of adverse action on correction, disclaimer, surrender, etc. of registration.....	2.176
Stays time in appeal, <i>inter partes</i> proceeding, or reply to Office action only when stay is specifically requested and granted	2.146(g)
Subject matter for petitions	2.146(a), (b)
Time to file petition	2.146(d), (e)
To accord filing date as of date of deposit as Express Mail	2.198
Pleading, amendment of	2.107, 2.115
Position of parties in <i>inter partes</i> proceedings	2.96, 2.99(e), 2.116(b)
Postal Service, United States, interruptions or emergencies in	2.195(e)
Post notice of allowance	2.88, 2.89
Post publication	2.81
Power of attorney or authorization of other representative	2.17, 2.19
Practice before the U.S. Patent and Trademark Office, individuals enti- tled to	11.14
Predecessor in title or related company, use by	2.38
Pre-trial conference, <i>inter partes</i> proceeding	2.120(i)(2)
Principal Register	2.46
Amendment to or from Supplemental Register	2.75
Printed publications, as evidence in <i>inter partes</i> proceedings	2.122(e)
Prior acts, status of prior registrations	2.158
Priority claim based on foreign application.....	2.34(a)(4), 7.27
Prior registrations, ownership, identification in application	2.36
Procedure in <i>inter partes</i> cases	2.116-2.136
Production of documents and things, request for (discovery)	2.120
Place of production.....	2.120(d)(2)
Motion for an order to compel production.....	2.120(e)
Timing of.....	2.120(a)
Professional conduct of attorneys	10.20-10.112
Proof of distinctiveness under sec. 2(f).....	2.41
Proof of service.....	2.119(a)
Protective order:	
Access to materials filed under	2.27(e)
Form of filing materials under	2.126(d)
Relating to discovery	2.120(f)
Relating to testimony	2.125(e)
Sanctions for violation.....	2.120(g), 2.125(e)
Publication and post publication	2.80-2.84
Publication in <i>Official Gazette</i> :	
Jurisdiction over published applications	2.84
Of claim of benefits under sec. 12(c) for marks registered under 1905 Act	2.154
Of first filed of applications for conflicting marks	2.83
Of mark on Principal Register for opposition after approval.....	2.80
Of marks on Supplemental Register when registered	2.82
Publication, notice by, undelivered Office notices to registrant in <i>inter</i> <i>partes</i> proceeding.....	2.118

R

Rebuttal testimony	(1)(b), (c)
Receipt of papers and fees	2.195-2.198, 7.4

Index II

Recognition of attorneys or other authorized person	2.17, 11.14
Reconsideration:	
Of affidavit or declaration of use under sec. 8	2.163(b), 2.165(a)
Of decision after final hearing in <i>inter partes</i> proceeding.....	2.129(c)
Of decision on <i>ex parte</i> appeal	2.144
Of decision on petition to Director	2.146(j)
Of decision on petition to revive.....	2.66(f)
Of final action	2.64(b)
Of order or decision on interlocutory motion.....	2.127(b)
Records of documents in Assignment Services Division of U.S. Patent and Trademark Office	3.11-3.56
Records and files of the U.S. Patent and Trademark Office.....	2.27, 2.200
Reexamination of application	2.63(a)
Reexamination of application after remand by the Trademark Trial and Appeal Board	2.130, 2.131, 2.142
Refund of money paid to U.S. Patent and Trademark Office.....	2.209
Refusal of affidavit or declaration of use under sec. 8	2.163
Refusal of affidavit or declaration of use under sec. 71	7.39
Refusal of registration	2.61
Refusal of renewal	2.184
Refusal of request for extension of time to file a statement of use	2.89(g)
Registered extension of protection. (See Extension of protection of international registration to United States)	
Registrability of marks in plurality of classes (combined applica- tions)	2.86
Registrant claiming benefits of 1946 Act	2.153-2.156
Registration as evidence in <i>inter partes</i> proceeding:	
File of registration which is the subject of the proceeding	2.122(b)(1)
Registration owned by any party to proceeding	2.122(d)(2)
Registration pleaded by opposer or petitioner	2.122(d)(1)
Registration records open to public inspection	2.27(d)
Registrations, printed copies available	2.201
Related company or predecessor, use by	2.38
Remand to Examiner:	
After decision in <i>inter partes</i> case	2.131
During appeal from refusal of registration	2.142(f)
During <i>inter partes</i> case	2.130
Renewal of registration.....	2.181-2.186, 7.41
Application for renewal, requirements	2.183
Failure to renew registration involved in <i>inter partes</i> proceeding	2.134(b)
Of international registration	7.41
Period in which to file	2.182
Refusal of renewal	2.184(a)
Review of Examiner's refusal by Director	2.186
Term of original registrations and renewals	2.181
Replacement	7.28, 7.29
Reply briefs in <i>inter partes</i> proceedings	2.127(a)
Representation by attorney	2.11
Representation of others before the U.S. Patent and Trademark Of- fice	2.11, 11.14
Representative, domestic or U.S. (See Domestic representative)	
Representation, recognition for	2.17, 11.14
Republication of marks registered under prior acts	2.153-2.156
Request for admissions (discovery). (See Admissions, request for)	
Request for Extension of protection of international registration to United States. (See Extension of protection of international registration to United States)	

37 CFR Ch. I (7–1–10 Edition)

Request for extension of time for discovery and testimony. (See Extension of time for discovery and testimony)	
Request for extension of time to file opposition. (See Extension of time for filing opposition)	
Request for extension of time to file statement of use. (See Extension of time to file statement of use)	
Request for information and exhibits by Examiner	2.61(b)
Request for production (discovery). (See Production of documents and things, request for)	
Request for reconsideration. See Reconsideration.	
Request for records	2.201
Request for registration	2.32(a)(1)
Request to divide an application	2.87
Request to divide a registration	2.171(b)
Requirements for receiving a filing date	2.21, 7.26
Requirements for written application	2.32, 2.34
Registration of marks registered under prior acts	2.158
Response to official action	2.62
Restriction on holder's right to dispose of international registration	7.24
Review by Director:	
For relief from repeated formal requirement by Examiner	2.63(b)
Of adverse action on correction, disclaimer, surrender, etc. of registration	2.176
Of refusal of affidavit or declaration of use under sec. 8	2.165
Of refusal of affidavit or declaration of use under sec. 71	7.40
Of refusal of renewal application	2.186
Petitions to the Director	2.146
Revival of abandoned applications	2.66
Revocation of power of attorney	2.19
Rules of evidence in <i>inter partes</i> cases	2.122(a)
Rules of practice in trademark cases:	
Suspension, petition to Director	2.146(a)(5), 2.148
Waiver, petition to Director	2.146(a)(5), 2.148

S

Sanction for failure to comply with discovery order	2.120(g)
Sanction for failure to comply with protective order relating to testimony	2.125(e)
Saturday, Sunday, or Federal holiday, time for taking action expiring on	2.195, 2.196
Schedule of classes of goods and services	2.85, 6.1-6.4
Schedule of time for discovery and trial periods	2.120(a), 2.121
Sec. 2(f), proof of distinctiveness	2.41
Sec. 8 affidavit or declaration of use	2.160-2.166
Sec. 44, application based on:	
Amendment to change application to different register	2.75(a)
Amendment to description or drawing in mark	2.72(c)
Basis for filing	2.34, 2.37
Certification mark	2.45(b)
Collective mark	2.44(b)
Drawing required	2.32(c)
Filing-date requirements	2.21
Goods or services identified may not exceed scope of those in foreign application or registration	2.32(a)(6)
Priority claim	2.34(a)(4)
Requirements for drawings	2.52-2.54
Requirements for written application	2.33, 2.34

Index II

Supplemental Register.....	2.47(b)
Sec. 71 affidavit or declaration of use.....	7.36-7.40
Service charge for filing renewal application during grace period	2.6, 2.185
Services marks	2.43
Specimens or facsimiles	2.56(c)
Service of copies of testimony	2.125
Service and signing of papers	2.119
Signature and certificate of attorney	11.18
Signature of applicant.....	2.33
Signature of electronically-filed document	2.33(d), 2.193(c)(1)(iii)
Single certificate for one mark registered in a plurality of classes.....	2.86(c)
Specimens.....	2.56-2.59
Electronically-filed	2.56(d)(4), 2.161(g)(3)
Facsimiles in lieu of specimens.....	2.56(c)
Not evidence in behalf of applicant or registrant in <i>inter partes</i> proceeding.....	2.122(b)(2)
Of service mark	2.56(a)(2)
Requirement of filing with affidavit or declaration of use under sec. 8.....	2.161(g)
Requirement of filing with affidavit or declaration of use under sec. 71.....	7.37(g)
Requirement of filing with amendment to allege use	2.76(b)(2), (e)(2)
Requirement of filing with statement of use	2.88(b)(2), (e)(2)
Support of amendment to application	2.71, 2.72
Support of amendment to registration	2.173
Statement of use	2.88
Amendments to description or drawing of mark after filing	2.72(b)(1)
Amendments to dates of use after filing	2.71(c)(2)
Extensions of time to file.....	2.89
Fee for filing	2.6
May not be withdrawn	2.88(g)
Minimum requirements for filing	2.88(e)
Requirements for	2.88(b)
Time for filing.....	2.88(a)
Status of application after <i>ex parte</i> appeal	2.142(g)
Status of application on termination of <i>inter partes</i> proceedings	2.136
Stipulated evidence, <i>inter partes</i> cases.....	2.123(b)
Stipulation to extend discovery and/or trial periods.....	2.120(a), 2.121
Subsequent designation.....	7.21
Address for mailing paper	2.190(a), 7.4(b)
Cannot be filed by fax.....	2.195(d)(5), 7.4(d)
Certificate of mailing or transmission does not apply	2.197(a)(2)
Fees for	7.7, 7.21(a)(8)
Must be filed through TEAS or on International Bureau's form	7.21(b)
Substitute specimens, filing of.....	2.59
Summary judgments in <i>inter partes</i> proceedings.....	2.127(e)(1)
Sunday, Saturday, or Federal holiday, time for taking action expiring on.....	2.195, 2.196
Supplemental Register:	
Amendment from Principal Register.....	2.47(c), 2.75
Application requirements	2.47
Approval.....	2.82
Cancellation.....	2.111
Certificate of registration	2.82
Intent-to-use applications, when eligible.....	2.47(c)
Marks published when registered.....	2.82
Marks in request for extension of protection of international registration not registrable on.....	2.47(c), 2.75(c)

37 CFR Ch. I (7–1–10 Edition)

Surrender of certificate of registration	2.172
During <i>inter partes</i> proceeding	2.134
Suspension of action in application by U.S. Patent and Trademark Office	2.67
Suspension from practice before U.S. Patent and Trademark Office	11.11; 11.25
Suspension of later filed conflicting application	2.83
Suspension of <i>inter partes</i> proceedings by Trademark Trial and Appeal Board:	
For good cause upon motion or stipulation	2.117(c)
Pending disposition of motion potentially dispositive of case	2.127(d)
Pending disposition of motion to compel	2.120(e)(2)
Pending disposition of motion to test sufficiency of response to request for admission	2.120(h)(2)
Pending termination of civil action or other Board proceeding	2.117(a), (b)
Suspension of rules, Director	2.146(a)(5), 2.148

T

TEAS	2.2(f), 2.6(a)(1), 2.33(d), 2.52(c), 2.56(d)(4), 2.161(g)(3), 2.193(c)(1)(iii)
Application filing fee	2.6(a)(1)
Definition of	2.2(f)
Drawing	2.52(d), 2.53
Signature	2.33(d), 2.193(c)(iii)
Specimen	2.56(d)(4), 2.161(g)(3)
TEAS Plus	2.6(a)(1)(iii), 2.22, 2.23
Term of original registrations and renewals	2.181
Testimony in <i>inter partes</i> cases:	
Assignment and resetting of times	2.121
By oral examination	2.123
By written questions	2.124
Failure to take	2.132
Filing and service of testimony	2.123(f), 2.124(f), 2.125
Arrangement, indexing, and form of transcript	2.123(g); 2.125 (b), (d)
Corrections to	2.124(f), 2.125(b)
Deposition must be filed	2.123(h)
Filing in U.S. Patent and Trademark Office	2.123(f), 2.124(f), 2.125(c)
Inspection of deposition	2.123(i)
Service on adverse party	2.124(f), 2.125(a)
From another proceeding	2.122(f)
In foreign countries	2.123(a)(2)
Objections to	2.123 (e), (j), (k); 2.124(d), (g)
Stipulated testimony	2.123(b)
Time:	
For amendment	2.62
For <i>ex parte</i> appeal	2.142(a)
For filing affidavit or declaration to avoid cancellation	2.160, 7.36
For filing amendment to allege use	2.76(a)
For filing appeal to court or civil action	2.145(d)
For filing briefs in <i>inter partes</i> proceedings	2.127
For filing extension of time to oppose	2.102
For filing opposition	2.101(c)
For filing petition for cancellation	2.111(b), (c)(3)
For filing request for extension of time to file statement of use	2.89
For filing request to divide application	2.87(c)
For filing statement of use	2.88(a)
For response to U.S. Patent and Trademark Office action	2.62
For taking discovery	2.120(a)
For taking testimony	2.121
Transformation	2.195(d)(5), 2.197(a)(2), 7.4(b)(2), 7.31

Index II

Translation of assignment	3.26
Transmission, certificate of.....	2.197

U

Undelivered Office notices, to registrant.....	2.118
Unprofessional conduct, attorneys	10.20-10.112
Unprovided for and extraordinary circumstances, petition to Director	2.146(a)(4), (5)
U.S. Court of Appeals for the Federal Circuit, appeal to	2.145
Use:	
Allegation of use in commerce	2.34, 2.76, 2.88
Amendment to allege use in commerce.....	2.76
Bona fide intention to use in commerce	2.34, 2.89
By predecessor or by related companies.....	2.38
Dates of first use and first use in commerce.....	2.34(a)(1)(ii) and (iii)
Statement of use	2.88
Use of discovery	2.120(j)

V

Verification:	
Declaration in lieu of oath or verification	2.20
In support of amendments to descriptions or drawings of the mark.....	2.72
In support of amendments to dates of use.....	2.71(c)
In support of request for extension of time to file statement of use	2.89
Of application.....	2.33
Of electronically-filed document	2.33(d), 2.193(c)(1)(iii)
Required with amendment to allege use	2.76(b)(1), (e)(3)
Required with statement of use	2.88(b)(1), (e)(3)
Required with substitute specimens	2.59

W

Waiver of rule, petition to Director.....	2.146(a)(5), 2.148
Willful false statements. declaration	2.20
Withdrawal from employment, practitioners.....	2.19, 10.40, 10.63
Withdrawal of amendment to allege use.....	2.76(h)
Withdrawal of application.....	2.68
Involved in <i>inter partes</i> proceeding.....	2.135
Withdrawal of opposition with or without consent	2.106(c)
Withdrawal of cancellation with or without consent	2.114(c)
Withdrawal of registration by voluntary surrender by registrant:	
Involved in cancellation proceeding	2.134
Requirements for	2.172
Withdrawal of statement of use prohibited.....	2.88(g)
Witnesses:	
Discovery deposition	2.120(b), (c)
Examination by oral deposition (Testimony)	2.123
Examination by written questions	2.124
Foreign	2.120(c), 2.123(a)(2)
Written application	2.32-2.47